UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,823	01/21/2004	David S. Benco	LUC-462/Benco 59-42-42-56	4074

32205	7590	10/25/2005	EXAMINER

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ART UNIT	PAPER NUMBER
2683	

DATE MAILED: 10/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/761,823	BENCO ET AL.
	Examiner	Art Unit	
	Stephen M. D'Agosta	2683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-20* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-20* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>21 January 2004</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All   b) ☐ Some * c) ☐ None of:

       1. ☐ Certified copies of the priority documents have been received.

       2. ☐ Certified copies of the priority documents have been received in Application No. _____.

       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4-5 and 9 rejected under 35 U.S.C. 102(e) as being anticipated by

McCarthy US 2003/0167230.

As per **claim 1,** McCarthy teaches method for providing network support for an

attribute feature for customization of mobile terminals by a telecommunication network

(title, abstract) the method comprising the steps of:

storing in the telecommunication network at least one attribute for use by at least

one mobile terminal (abstract teaches content available in the network for download to

mobile device. Also see figure 3.);

sending at least one attribute request from the mobile terminal to the

telecommunication network (figure 3 shows step of wireless terminal requesting

download from WAP portal thru to Content Provider, steps #60-61);

recognizing, by the telecommunication network, the attribute request from the

mobile terminal (figure 3 shows steps #61-67 whereby network validates user account

and item to be downloaded);

downloading, by the telecommunication network, the requested attribute to the

mobile terminal (figure 3 shows steps #67-#70 whereby item is fetched and

downloaded); and

installing the attribute in the mobile terminal (figure 3, step 73 shows item being saved/stored on mobile device. Also see figures 4-6 and Para's 0003-0007 which teach downloading/storing ring tunes, tactile feedback, graphic icon, animation, background, etc.).

As per **claim 2,** McCarthy teaches claim 1 wherein the method further comprises the steps of:

storing the at least one attribute in an attribute database in the telecommunication network (figure 3 shows a content provider #53 which stores the attributes in a database while figure 4 furthers this concept since it shows the user being able to select multiple tones 5.1, games 5.2, images 5.3); and

retrieving, in response to the attribute request, the attribute from the attribute database (figure 3 shows the user requesting and the system fetching/sending the selected attribute).

As per **claims 4-5,** McCarthy teaches claim 1 wherein the attribute request/download is a request of a plurality of attributes in an attribute package (figure 4 shows the user can select from a listing of items to download, including tones, games, images, etc.. Figure 5 shows that the user can download and save an item, step #110, and then go back and request more items to download, see line from #110 to #101, which reads on the claim).

As per **claim 9,** McCarthy teaches claim 1 wherein the method further comprises the steps of:

navigating through an attribute menu on the mobile terminal and selecting from the attribute menu at least one attribute to be requested (see figure 6 which shows a user navigating through attribute menus and selecting a ring tone to download).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3, 6 and 8 rejected under 35 U.S.C. 103(a) as being unpatentable over

McCarthy and further in view of Kim KR2001-110374.

As per **claim 3,** McCarthy teaches claim 1 wherein the method further comprises

receiving future messages to the mobile terminal in a format consistent with the

downloaded attribute (figure 6 shows selecting/downloading ring tones whereby the

user's phone would use said downloaded ring tone for future received messages, see

6.3 which shows "Save and Activate" under "Tone Options") **but is silent on** receiving

future messages in a format consistent with the downloaded attribute.

Kim teaches a method for downloading a font to a cellular phone so that a user

can easily change the existing font (abstract).

It would have been obvious to one skilled in the art at the time of the invention to

modify McCarthy, such that it receives future messages in a format consistent with the

downloaded attribute, to provide means to download new settings to the cell phone (eg.

attribute, ring tone, game, etc.) .

As per **claim 6,** McCarthy teaches claim 4 wherein the attribute package is an

image (figure 4, section 5.3 shows that images can be selected) **but is silent on** a

combination of at least two of; background colors, foreground colors, font styles, font

sizes, low-light level mode, and bright-light level mode.

McCarthy does teach downloading ring tunes, games, backgrounds for games,

etc.. Hence one skilled would provide for downloading colors, fonts, low/bright level

modes.

Kim teaches a method for downloading a font to a cellular phone so that a user can easily change the existing font (abstract).

It would have been obvious to one skilled in the art at the time of the invention to modify McCarthy, such that it is a combination of at least two of; background colors, foreground colors, font styles, font sizes, low-light level mode, and bright-light level mode, to provide means to download new settings to the cell phone (eg. attribute, ring tone, game, etc.) .

As per **claim 8,** McCarthy teaches claim 1 wherein the attribute an image (figure 4, section 5.3 shows that images can be selected) **but is silent on** one of background colors, foreground colors, font styles, font sizes, low-light level mode, and bright-light level mode.

McCarthy does teach downloading ring tunes, games, backgrounds for games, etc.. Hence one skilled would provide for downloading colors, fonts, low/bright level modes.

Kim teaches a method for downloading a font to a cellular phone so that a user can easily change the existing font (abstract).

It would have been obvious to one skilled in the art at the time of the invention to modify McCarthy, such that it is at least one of; background colors, foreground colors, font styles, font sizes, low-light level mode, and bright-light level mode, to provide means to download new settings to the cell phone (eg. attribute, ring tone, game, etc.) .

Claim 7 rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy and further in view of Staack US 2004/0078439.

As per **claim 7,** McCarthy teaches claim 1 **but is silent on** wherein the method further comprises: ﹨

storing in a subscriber database a data entry indicative of the mobile terminal being a subscriber of the attribute feature; and

checking, upon receiving an attribute request, the subscriber database for the mobile terminal being a subscriber of the attribute feature of the telecommunication network.

McCarthy does teach checking to see if the selected item/attribute is available for download, checking to see if the user can pay and checking to see that memory is available to store the item/attribute (see figure 3). Hence one skilled would also provide a check to see what items/attributes the user already has loaded so as not to allow the user to pay for an item/attribute they already have stored on their phone. Figure 3 explicitly teaches updating the user's account (steps 70-71) which reads on updating the subscriber database.

Staack teaches the HLR stores user profile/attribute information:

"...A user database 24 is provided. The user database contains user related information such as subscription information and configuration information. This can include user profiles and the home location register. In the embodiment shown in FIG. 2, the user database is shown as a single entity. ..." (Para. 0022). The examiner interprets the user related information such as subscription information and configuration information as storing the phone's attributes as well.

It would have been obvious to one skilled in the art at the time of the invention to modify McCarthy, such that it stores in a subscriber database a data entry indicative of the mobile terminal being a subscriber of the attribute feature and checks upon receiving an attribute request, the subscriber database for the mobile terminal being a subscriber of the attribute feature of the telecommunication network, to provide means for only allowing the user to download items/attributes they don't have stored on their phone.

Claims 10-20 rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy and further in view of Kim and Staack.

As per **claims 10 and 16,** McCarthy teaches a method for providing network support for an attribute feature for customization of mobile terminals by a telecommunication network (title, abstract), the method comprising the steps of:

sending at least one attribute request from the mobile terminal to the telecommunication network (figure 3 shows step of wireless terminal requesting download from WAP portal thru to Content Provider, steps #60-61);;

recognizing, by the telecommunication network, the attribute request from the mobile terminal (figure 3 shows steps #61-67 whereby network validates user account and item to be downloaded);

downloading, by the telecommunication network, the requested attribute to the mobile terminal (figure 3 shows steps #67-#70 whereby item is fetched and downloaded);

installing the attribute in the mobile terminal (figure 3, step 73 shows item being saved/stored on mobile device. Also see figures 4-6 and Para's 0003-0007 which teach downloading/storing ring tunes, tactile feedback, graphic icon, animation, background, etc.); and

But is silent on

storing in an attribute database in the telecommunication network at least one attribute for use by at least one mobile terminal;

storing in a subscriber database a data entry indicative of the mobile terminal being a subscriber of the attribute feature;

checking, upon receiving an attribute request, the subscriber database for the mobile terminal being a subscriber of the attribute feature of the telecommunication network;

retrieving, in response to the attribute request and in response to the mobile terminal being a subscriber of the attribute feature, the attribute from the attribute database; and

formatting future messages to the mobile terminal in a format consistent with the downloaded attribute.

McCarthy does teach checking to see if the selected item/attribute is available for download, checking to see if the user can pay and checking to see that memory is available to store the item/attribute (see figure 3). Hence one skilled would also provide a check to see what items/attributes the user already has loaded so as not to allow the user to pay for an item/attribute they already have stored on their phone. Figure 3 explicitly teaches updating the user's account (steps 70-71) which reads on updating the subscriber database.

Kim teaches a method for downloading a font to a cellular phone so that a user can easily change the existing font (abstract).

Staack teaches the HLR stores user profile/attribute information:

"...A user database 24 is provided. The user database contains user related information such as subscription information and configuration information. This can include user profiles and the home location register. In the embodiment shown in FIG. 2, the user database is shown as a single entity. ..." (Para. 0022). The examiner interprets the user related information such as subscription information and configuration information as storing the phone's attributes as well.

It would have been obvious to one skilled in the art at the time of the invention to modify McCarthy, such that it stores in a subscriber database a data entry indicative of the mobile terminal being a subscriber of the attribute feature and checks upon receiving an attribute request, the subscriber database for the mobile terminal being a subscriber of the attribute feature of the telecommunication network and future messages are consistent with the attribute download, to provide means for only allowing the user to download items/attributes they don't have stored on their phone whereby all future messages are received in the new attribute's setting(s).

With further regard to claim 16, McCarthy teaches navigating through an attribute menu on the mobile terminal and selecting from the attribute menu at least one

attribute to be requested (see figure 6 which shows a user navigating through attribute menus and selecting a ring tone to download) and a recognition module, upon receiving an attribute request, checking the subscriber database for the mobile terminal being a subscriber of the attribute feature of the telecommunication network, and outputting a confirmation message when the mobile terminal is a subscriber of the attribute feature (figure 3 shows checking if account is valid, and when verified, sending the item list to the user, which reads on a confirmation message since the item list will not be sent if the user's account is not verified).

As per **claims 11 and 17,** McCarthy teaches claim 10/16 wherein the attribute an image (figure 4, section 5.3 shows that images can be selected) **but is silent on** one of background colors, foreground colors, font styles, font sizes, low-light level mode, and bright-light level mode.

McCarthy does teach downloading ring tunes, games, backgrounds for games, etc.. Hence one skilled would provide for downloading colors, fonts, low/bright level modes.

Kim teaches a method for downloading a font to a cellular phone so that a user can easily change the existing font (abstract).

It would have been obvious to one skilled in the art at the time of the invention to modify McCarthy, such that it is at least one of; background colors, foreground colors, font styles, font sizes, low-light level mode, and bright-light level mode, to provide means to download new settings to the cell phone (eg. attribute, ring tone, game, etc.) .

As per **claims 12-13 and 18-19,** McCarthy teaches claim 1/16 wherein the attribute request/download is a request of a plurality of attributes in an attribute package (figure 4 shows the user can select from a listing of items to download, including tones, games, images, etc.. Figure 5 shows that the user can download and save an item, step #110, and then go back and request more items to download, see line from #110 to #101, which reads on the claim)

As per **claims 14 and 20,** McCarthy teaches claim 12/17 wherein the attribute package is an image (figure 4, section 5.3 shows that images can be selected) **but is silent on** a combination of at least two of; background colors, foreground colors, font styles, font sizes, low-light level mode, and bright-light level mode.

McCarthy does teach downloading ring tunes, games, backgrounds for games, etc.. Hence one skilled would provide for downloading colors, fonts, low/bright level modes.

Kim teaches a method for downloading a font to a cellular phone so that a user can easily change the existing font (abstract).

It would have been obvious to one skilled in the art at the time of the invention to modify McCarthy, such that it is a combination of at least two of; background colors, foreground colors, font styles, font sizes, low-light level mode, and bright-light level mode, to provide means to download new settings to the cell phone (eg. attribute, ring tone, game, etc.) .

As per **claim 15,** McCarthy teaches claim 10 wherein the method further comprises the steps of:

navigating through an attribute menu on the mobile terminal and selecting from the attribute menu at least one attribute to be requested (see figure 6 which shows a user navigating through attribute menus and selecting a ring tone to download).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Park KR2002-079660

2. Yoon et al. US 6,628,971

3. Birgerson US 6,138,009

4. McIntyer et al. US 2003/0218636

5. Kishida et al. US 2002/0045465

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 571-272-7862. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen D'Agosta
Primary Examiner
9-28-2005